



20

BD of Appeal #20

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
Dickinson, et al.) Senior Administrative
) Patent Judge: McCandlish
Appeal No.: 98-2326)
) Administrative
Reissue) Patent Judges:
Serial No.: 08/427,070) Abrams and McQuade
)
Filed: April 24, 1995)
)
For: **MAGNETIC RESONANCE**)
 APPARATUS)
)
Date of Last Office Action:)
August 20, 1998)
)
Attorney Docket No.:) Cleveland, Ohio 44114
PKR 2 363-4) October 20, 1998

REQUEST TO REMAND
APPLICATION TO THE EXAMINER

Box AF

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This paper is responsive to the Decision on Appeal issued August 20, 1998. Appellants respectfully request the Board of Patent Appeals and Interferences ("the Board") remand the above-referenced reissue application to the Examiner. A Request to Suspend Prosecution of the reissue application is being submitted along with this paper.

The Decision on Appeal

Claims 1-13 stand allowed.

The Board sustained the Examiner's rejection of **claims 14-17** under 35 U.S.C. §103 as being unpatentable over Matsutani (U.S. Patent No. 4,875,485) in view of LeVeon (U.S. Patent No. 4,230,129).

BOARD OF PATENT APPEALS
AND INTERFERENCES
1998 OCT 27 PM 3:02

The Board entered a new rejection of **claims 14-17** under 35 U.S.C. §251 and, alternatively, under 35 U.S.C. §112, first paragraph, as containing new matter not supported by the original disclosure of the patent upon which the reissue application is based.

The Board reiterated 37 C.F.R. §1.196(b), which provides that appellants must exercise one of two options with respect to the new ground of rejection.

Appellants Election Under 37 C.F.R. §1.196(b) (1)

Regarding the new ground of rejection, appellants elect to remand the reissue application to the Primary Examiner pursuant to 37 C.F.R. §1.196(b) (1).

Showing of Facts Relating to the Rejected Claims

New matter is "matter not present in the patent sought to be reissued." MPEP §1411.02. The Board's new matter rejection appears to be based upon deviations in the reissue application from column 3, lines 38-39 and Figure 4 of the original patent. More specifically, column 3, lines 34-41 of the reissue application state:

"Referring to FIGS. 3, 4 and 5, the patient handling equipment of this embodiment comprises a lower horizontal rectangular planar table portion **31** mounted with its longer axis parallel to the longer horizontal axis of the magnetic core arrangement on rails or rollers **32** [(not shown)], just above the face of the lower pole piece **1**, so as to be slidable in a horizontal plane in a direction orthogonal to the longer axis of the core arrangement."

Figure 4 of the original patent did not represent the rails or rollers. However, Figure 4 of the reissue application has been amended to include phantom lines illustrating these elements, along with the addition of reference numeral 32. The phantom lines do not portray any

specific structure for the rails or rollers. Instead, the phantom lines merely indicate a generic structure representing any implementation of rails or rollers. Figures 3 and 5 represent different views of Figure 4 and, consequently, have also been amended for consistency.

Appellants point out that the specification of the original patent already disclosed the rails or rollers identified in the reissue application. Because the phantom lines illustrated in Figures 3-5 do not illustrate any specific implementation of the rails or rollers disclosed in the original application, those illustrated elements are not new matter. Therefore, the addition of the reference numeral 32 in the specification, and the phantom lines in FIGURE 4, are supported by the disclosure of the patent upon which the reissue application is based.

More specifically, the rails or rollers disclosed in the specification of the original patent provide support for the "spaced-apart structures" (recited at lines 6-7 of **claim 14**), which support and depend from a horizontal patient bed. The spaced-apart structures define an opening under the bed sized to pass a lower magnet pole therethrough. Similarly, the rails or rollers disclosed in the specification of the original patent provide support for defining the "aperture" (recited in line 9 of **claim 16**), which is moved over a lower pole face of a magnet in an open gap, below a patient bed. The aperture is defined (in lines 4-5 of **claim 16**) to be in an undercarriage disposed below the patient bed. Consequently, **claims 14 and 16** of the reissue application are supported by the original disclosure of the patent upon which the reissue application is based. Furthermore, **claims 14 and 16** call for matter which the applicant had the right to claim in the original patent.

For the reasons stated above, **claims 14 and 16** do not contain new matter not supported by the original disclosure of the patent upon which the reissue application is

based. Therefore, **claims 14 and 16** are in condition for allowance.

Although the Board also rejected **claims 15 and 17** as containing new matter, no specific examples were cited. Furthermore, **claims 15 and 17** depend from and merely add limitations to the detailed subject matter of their parent claims. Appellants submit dependent **claims 15 and 17** do not contain any matter not supported by the original disclosure of the patent upon which the reissue application is based. Therefore, **claims 15 and 17** are also believed to be in condition for allowance.

Claims 14-17 of the Present Reissue Application Distinguish Over the Cited References

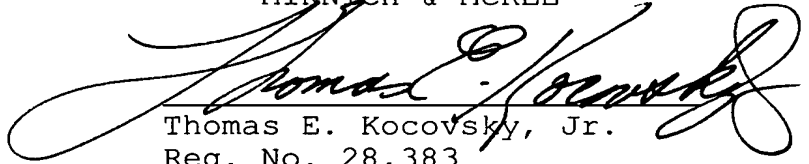
Applicants maintain, as pointed out in detail in the Preliminary Submission of April 24, 1995, the Brief of December 4, 1997, and the Reply Brief of March 20, 1998, that the present reissue claims are copied from claims 2, 5, 10 and 11 of U.S. Patent No. 5,305,749 of Li et al. for purposes of invoking an interference. The applicants request reconsideration of the rejection of the claims of an issued U.S. Letters Patent. Therefore, **claims 14 and 16** of the present reissue application are patentable. As dependent **claims 15 and 17** of the present reissue application depend from and further limit independent **claims 14 and 16**, respectively, it is submitted they are also patentable.

Alternatively, if the combination of Matsutani and LeVeen is held to render **claims 14-17** of the present reissue application obvious under 35 U.S.C. §103, applicants believe

claims 2, 5, 10 and 11 of U.S. Patent No. 5,305,749 to Li et al. are invalid.

Respectfully submitted,

FAY, SHARPE, BEALL, FAGAN,
MINNICH & MCKEE



Thomas E. Kocovsky, Jr.
Reg. No. 28,383
7TH Floor
1100 Superior Avenue
Cleveland, Ohio 44114-2518
(216) 861-5582

CERTIFICATE OF MAILING

I hereby certify that this REQUEST TO REMAND APPLICATION TO THE EXAMINER for U.S. Reissue Serial No. 08/427,070 (Appeal No. 98-2326) is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Box AF**, Assistant Commissioner for Patents, Washington, D.C. 20231 on this 20th day of October, 1998.



Brian E. Kondas

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	
Dickinson, et al.)	Senior Administrative
)	Patent Judge: McCandlish
Appeal No.: 98-2326)	
)	Administrative
Reissue)	Patent Judges:
Serial No.: 08/427,070)	Abrams and McQuade
)	
Filed: April 24, 1995)	
)	
For: MAGNETIC RESONANCE)	
APPARATUS)	
)	
Date of Last Office Action:)	
August 20, 1998)	
)	
Attorney Docket No.:)	Cleveland, Ohio 44114
PKR 2 363-4)	October 20, 1998

REQUEST FOR SUSPENSION OF PROSECUTION

Box AF

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Appellants request the prosecution of the above-referenced reissue application be suspended pending a decision of a Request for Reexamination of U.S. Patent No. 5,305,749 ("the '749 patent") to Li, et al.

The Request for Reexamination, which was filed June 16, 1998 and assigned Reexam Control No. 90/005,017, includes a statement raising a substantial new question of patentability regarding the '749 patent. The statement sets forth two (2) reasons to support its assertion. First, U.S. Patent No. 5,207,224 to Dickinson, U.S. Patent No. 4,875,485 to Matsutani, and U.S. Patent No. 4,230,129 to LeVeon were not of record in the file of the '749 patent. Second, at least claims 2, 5, 10, and 11 of the '749 patent are unpatentable

under 35 U.S.C. §103 over Matsutani and LeVeen and anticipated under 35 U.S.C. §102 by Dickinson.

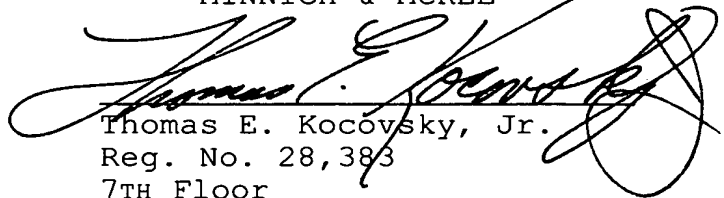
On August 4, 1998, the United States Patent and Trademark Office issued an Order Granting the Request for Reexamination (see Exhibit A). The Order states a substantial new question of patentability affecting claims 1-11 of the '749 patent is raised by the Request for Reexam.

It is believed the decision reached in the Reexamination proceeding will influence the prosecution of the present reissue application. In fact, fairness dictates that the decisions reached in the corresponding applications be consistent. Therefore, if the Reexamination results in the patent claims being held unpatentable, the appellants herein will withdraw the corresponding copied claims in this application. If, on the other hand, the Reexamination results in the patent claims being held patentable, the appellants submit that a consistent result dictates that the corresponding copied claims be allowed in this reissue application.

For the reasons stated above, appellants request the prosecution of the reissue application be suspended pending the decision in the corresponding Reexamination proceeding.

Respectfully submitted,

FAY, SHARPE, BEALL, FAGAN,
MINNICH & McKEE

A handwritten signature in dark ink, appearing to read "Thomas E. Kocovsky, Jr.", is written over the printed name and address. The signature is stylized with a large, looping initial 'T' and 'K'.

Thomas E. Kocovsky, Jr.
Reg. No. 28,383
7TH Floor
1100 Superior Avenue
Cleveland, Ohio 44114-2518
(216) 861-5582

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	
Dickinson, et al.)	Senior Administrative
)	Patent Judge: McCandlish
Appeal No.: 98-2326)	
)	Administrative
Reissue)	Patent Judges:
Serial No.: 08/427,070)	Abrams and McQuade
)	
Filed: April 24, 1995)	
)	
For: MAGNETIC RESONANCE)	
APPARATUS)	
)	
Date of Last Office Action:)	
August 20, 1998)	
)	
Attorney Docket No.:)	Cleveland, Ohio 44114
PKR 2 363-4)	October 20, 1998

CERTIFICATE OF MAILING

I hereby certify that this **REQUEST FOR SUSPENSION OF PROSECUTION** for U.S. Reissue Serial No. 08/427,070 (Appeal No. 98-2326) is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Box AF**, Assistant Commissioner for Patents, Washington, D.C. 20231 on this 20th day of October, 1998.


Brian E. Kondas



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTERS CORRESPONDENCE ADDRESS)

Thomas E. Kocovsky, Jr.
Fay Shorpe Beull Fagan
Minnich & Metee
1100 Superior Ave, 7th Fl.
Cleveland, OH 44114-2518

RECEIVED

AUG 06 1993

FAY, SHORPE, BEULL, FAGAN,
MINNICH & METEE

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005017

PATENT NO. 5,305,749

ART UNIT 3737

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding. 37 C.F.R. 1.550(e).

Where this copy is supplied after the reply by requester, 37 C.F.R. 1.535, or the time for filing a reply has passed, no submissions on behalf of the reexamination requester will be acknowledged or considered. 37 C.F.R. 1.550(e).

"BOCKETED"



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

CONTROL NUMBER	FILING DATE	PATENT UNDER REEXAMINATION	ATTORNEY DOCKET NO.
----------------	-------------	----------------------------	---------------------

90/005,017 06/16/98 5305749

EXAMINER	FIG 7-452
----------	-----------

LARRY G. NIXON
NIXON AND VANDERBYE
1100 NORTH GLIDE ROAD
8TH FLOOR
ARLINGTON VA 22203-4714

004170004

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED: 7/27/98

06/04/98

ORDER GRANTING/DENYING REQUEST FOR REEXAMINATION

The request for reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): ☐ PTO-892, ☒ PTO-1449, ☐ Other: _____

1. ☒ The request for reexamination is GRANTED.

RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Statement (optional): TWO MONTHS from the mailing date hereof. 37 CFR 1.530(b).
EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

For Requester's reply (optional): TWO MONTHS from the date of service of any patent owner's statement. 37 CFR 1.535. **NO EXTENSION OF TIME IS PERMITTED.** If patent owner does not file a timely statement under 37 C.F.R. 1.530(b), no reply by requester is permitted.

2. ☐ The request for reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 303(c). Requester may seek review by petition to the Commissioner within ONE MONTH from the mailing date hereof. 37 CFR 1.515(c). **EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26(c) will be made to requester (listed below if not patent owner)
☐ by Treasury check, ☐ by credit to Deposit Account No. _____
unless notified otherwise. 35 U.S.C. 303(c).

(Third party requester's correspondence address)

A substantial new question of patentability affecting claims 1-11 of United States Patent Number 5,305,749 to Li et al is raised by the request for reexamination.

Extensions of time under 37 C.F.R. § 1.136(a) will not be permitted in these proceedings because the provisions of 37 C.F.R. § 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, Office policy requires that reexamination proceedings "will be conducted with special dispatch" (37 C.F.R. § 1.550(a)) and provides for extensions of time in reexamination proceedings as set forth in 37 C.F.R. § 1.550(c).

The request indicates that the Requestor considers that claims 2,5,10,11 are unpatentable over Matsutani in view of LeVeen.

The request further indicates that the Requestor considers that claims 2,5,10,11 are unpatentable over Dickinson et al.

It is agreed that the consideration of Matsutani in view of LeVeen raises a substantial new question of patentability as to claims 2,5,10,11 of the Li et al patent. As pointed out in the request, Matsutani discloses a magnetic resonance system having a patient bed with an opening under the support of the bed allowing the bed to be positioned over the lower pole of the MR system but does not disclose a patient support having spaced apart structures supporting the bed and depending therefrom and defining an opening under the bed sized to pass the lower pole of the magnet. A reasonable examiner would consider the LeVeen reference important to the examination of the Li et al patent as the reference discloses a medical system having a patient support with two supporting structures located at opposite ends of the patient bed.

Serial Number: 90/005,017
Art Unit: 3737

-3-

If considered alone, the Dickinson et al patent would be precluded as prior art in view of In re Portola Packaging Inc. 42 USPQ 2d 1295 (Fed Cir. 1997).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is (703) 308-3063.

**RUTH S. SMITH
PRIMARY EXAMINER
ART UNIT 3737**

RSS
August 3, 1998

Subst. Form PTO-1449

Atty. Docket No.: PKR 7 493

Serial No.:

**APPLICANT'S(S) INFORMATION
DISCLOSURE STATEMENT**

Applicant(s):

Filing Date:

Group:

U.S. PATENT DOCUMENTS

Initial*		Document No.	Date	Name	Class	Subcl.	Filing Date
<i>AA</i>	AA	4,230,129	10-28-80	LeVeen			
<i>AB</i>	AB	4,875,485	10-24-89	Matsutani			
<i>AC</i>	AC	5,207,224	05-04-93	Dickinson, et al.			
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

		Document No.	Date	Country	Class	Subcl.	Translation?
	AL						
	AM						
	AN						
	AO						
	AP						

OTHER ART

	AR	
	AS	
	AT	

Examiner:

Date Considered: 8/5/98

* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if in conformance and not considered. Include copy of this form with next communication to applicant.



AT/Gen

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	
Dickinson, et al.)	Senior Administrative
)	Patent Judge: McCandlish
Appeal No.: 98-2326)	
)	Administrative
Reissue)	Patent Judges:
Serial No.: 08/427,070)	Abrams and McQuade
)	
Filed: April 24, 1995)	
)	
For: MAGNETIC RESONANCE)	
APPARATUS)	
)	
Date of Last Office Action:)	
August 20, 1998)	
)	
Attorney Docket No.:)	Cleveland, Ohio 44114
PKR 2 363-4)	October 20, 1998

REQUEST FOR DRAWING AMENDMENT

Box AF

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Approval to amend Figures 3, 4, and 5 is respectfully requested.

More specifically, please amend Figure 4 to indicate the rails or rollers, indicated by reference numeral 32, with phantom lines.

Also, please amend Figure 3 to include the phantom lines representing the rails or rollers 32 and to indicate the pole 1. Furthermore, please amend Figure 5 to include the phantom lines representing the rails or rollers 32. Because Figures 3 and 5 represent different views of the structure illustrated in Figure 4, the amendments to Figures 3 and 5 merely make those figures consistent with Figure 4.

The above modifications are shown in red in the enclosed drawing copies.

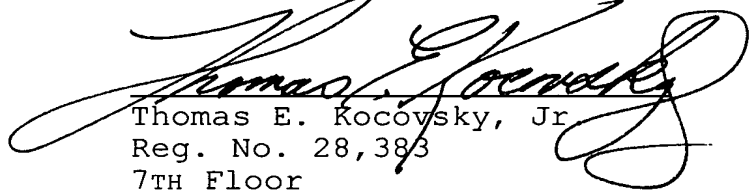
The foregoing requested changes find clear support in the original application as filed and no new subject matter is being added thereby.

Upon approval, and once the application has been allowed, the requested changes to these figures will be incorporated into the formal drawings which will then be filed.

A duplicate copy of this request and of the figures are being enclosed herewith.

Respectfully submitted,

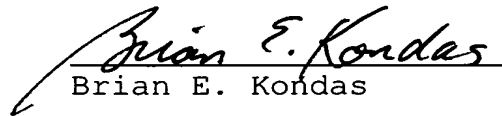
FAY, SHARPE, BEALL, FAGAN,
MINNICH & McKEE



Thomas E. Kocovsky, Jr
Reg. No. 28,383
7TH Floor
1100 Superior Avenue
Cleveland, Ohio 44114-2518
(216) 861-5582

CERTIFICATE OF MAILING

I hereby certify that this **REQUEST FOR DRAWING AMENDMENT** for U.S. Reissue Serial No. 08/427,070 (Appeal No. 98-2326) is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Box AF**, Assistant Commissioner for Patents, Washington, D.C. 20231 on this 20th day of October, 1998.



Brian E. Kondas